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Technology Center 2100

In re Application of:)
MORITA, Toshihiro et al.)
Application No. 09/913,586) **DECISION ON PETITION TO**
Filed: August 15, 2001) **WITHDRAW THE 37 CFR 1.105**
For: **INFORMATION PROCESSING**) **REQUIREMENT FOR**
APPARATUS AND ASSOCIATED) **INFORMATION**
METHOD OF TRANSFERRING)
GROUPED CONTENT)

This is a decision on the petition, filed on August 16, 2006, under 37 CFR 1.181 to withdraw the requirement for information under 37 CFR 1.105.

The petition is **GRANTED**.

Applicant states that the requests for items (A) and (F) of the 1.105 requirement is improper. Items (A) and (F) from the examiner's action dated July 7, 2006 stated the following:

(A) Stipulate whether each and every individually cited reference listed on the IDS(s) submitted on 05/17/2006, 2/15/2006, 02/01/2006, 12/23/2005, 08/23/2005, 08/11/2003 and 08/15/2001 is material to the patentability of the instant application; the applicant may either agree or disagree for each cited reference.

(F) In order to constitute a complete response Applicant is required to include stipulations for each and every reference cited in the IDS submission(s) dated 5/17/2006, 2/15/2006, 2/1/2006, 12/23/2005, 8/23/2005, 8/11/2003 and 8/15/2001 as well as each and every IDS submission thereafter, as delineated in requirement A.

Applicant's basis for the improper 1.105 requirement is that under 37 CFR 1.97(h) the filing of information disclosure statement is not considered to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in 37 CFR 1.56. Information relative to the materiality of each reference is either unknown or not readily available to Applicants. The Examiner determines what is material, not Applicants, and thus the Rule 105 improperly requests Applicants to express their opinion. Moreover, Applicants respectfully submit that they are not required to formulate such an opinion as noted above. Accordingly, Applicants respectfully submit that this request for information is improper.

REGULATION AND PROCEDURES

MPEP 704.11 states that:

There must be a reasonable basis for the information required that would aid in the examination of an application or treatment of some matter. A requirement for information under 37 CFR 1.105 places a substantial burden on the applicant that is to be minimized by clearly focusing the reason for the requirement and the scope of the expected response. Thus, the scope of the requirement should be narrowly defined, and a requirement under 37 CFR 1.105 may only be made when the examiner has a reasonable basis for requiring information.

The terms "factual" and "facts" are included in 37 CFR 1.105 to make it clear that it is facts and factual information, that are known to applicant, or readily obtained after reasonable inquiry by applicant, that are sought, and that requirements under 37 CFR 1.105 are not requesting opinions that may be held or would be required to be formulated by applicant. Where the factual information requested related to the subject application, and details thereof, applicant would be expected to make a reasonable inquiry under the circumstances to find the factual information requested (37 CFR 10.18(b)(2)). Applicant need not, however, derive or independently discover a fact, such as by experimentation, in response to a requirement for information. The purpose of 37 CFR 1.105 is to improve patent quality, and render better decisions, and not to put applicants in jeopardy of meeting their duties of candor and good faith in their replies to a requirement for information.

Decision

The Applicant's remarks are persuasive and the petition is **GRANTED**. The suspension and shortened statutory period established in the paper mailed July 24, 2006 are withdrawn. The application is restored to amended status and the file forwarded to the examiner to act promptly on the amendments filed December 23, 2005 and April 10, 2006.

Any question concerning this decision should be directed to John Follansbee whose telephone number is 571-272-3964.

The application is being forwarded to the examiner for appropriate action.



Paul Sewell, Director
Technology Center 2100